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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,299	12/05/2000	Kenneth H. Falchuk	healre01.012	7848

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EXAMINER
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PASS, NATALIE

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/730,299

**Applicant(s)**

FALCHUK ET AL.

**Examiner**

Natalie A. Pass

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the amendment filed 6 October 2004. Claims 1-4 remain pending.

### ***Specification***

2. The abstract of the disclosure is objected to because it exceeds 150 words in length. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC §101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

4. Claims 1-4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural

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phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-4 only recite abstract ideas. The recited claims detailing the steps of receiving and providing comments and instructional material and grading answers and providing credits do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute different parts of a method and system of providing continuing education medical credits to a physician.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a telecommunications system to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. Regarding the body of the claims, mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

In this regard the Examiner notes that although claims 1-4 recite a telecommunications system for connecting physicians and for receiving a comment and for providing instructional material, which are included in the technological arts, the computer usage is interpreted as

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merely storing and sending data which is to be read or outputted by a computer without any functional interrelationship, and thus does not impart functionality to the computer, rendering it an example of non-functional descriptive material per se; furthermore, the remainder of the claim limitations of claims 1-4 fail to apply, involve, use, or advance the technological arts.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces a continuing medical education credit (i.e., repeatable) that can be used in enabling physician accreditation (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-4 are deemed to be directed to non-statutory subject matter.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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6. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Minnesota Medical Association Report on Telemedicine article, September 1996, URL: <http://www.mnmed.org/Protected/telemedicine.pdf>, hereinafter known as Telemedicine.

(A) As per claim 1, Telemedicine teaches a method of providing continuing medical education credit to a first physician who has been engaged in a consultation with a second physician via an intermediary, the intermediary being connected by a telecommunications system to both the first and second physicians, the method comprising the steps performed in the intermediary of:

receiving a comment or information made with regard to the consultation via the telecommunications system from the second physician (Telemedicine; page 1, column 2, paragraph 2 to page 2, column 1, paragraph 1, page 3, column 1, paragraph 4, page 4, column 2, paragraph 4, page 14, column 1, paragraphs 3-4, page 18, column 2, paragraph 2, page 19, column 1, paragraphs 2-3, page 22, column 1, paragraph 4 to column 2, paragraph 2); and

providing the comment to a medical information specialist in the intermediary who is neither the first nor the second physician, the medical information specialist indicating continuing medical education credit for the first physician based at least on the comment in a database accessible from the intermediary (Telemedicine; page 1, column 2, paragraph 2 to page 2, column 1, paragraph 1, page 3, column 1, paragraph 4, page 4, column 2, paragraph 4, page 14, column 1, paragraphs 3-4, page 19, column 1, paragraphs 2-3, page 22, column 1, paragraph 4 to column 2, paragraph 2).

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(B) As per claim 2, Telemedicine teaches a method as analyzed and discussed in claim 1 above

wherein the method further comprises the steps of:

retrieving instructional material or information relevant to the comment and the consultation from the information data base (Telemedicine; page 3, column 1, paragraph 4 to column 2, paragraph 1, page 8, column 2, paragraph 1, page 9, column 1, paragraph 3, page 14, column 1, paragraphs 2 to column 2, paragraph 1, page 15, column 1, paragraph 4 to column 2, paragraph 1, page 19, column 1, paragraph 2 to column 2, paragraph 2, page 22, column 1, paragraph 4 to column 2, paragraph 2); and

providing the instructional material to the first physician via the telecommunications system (Telemedicine; page 3, column 1, paragraph 4 to column 2, paragraph 1, page 8, column 2, paragraph 1, page 9, column 1, paragraph 3, page 14, column 1, paragraphs 2 to column 2, paragraph 1, page 15, column 1, paragraph 4 to column 2, paragraph 1, page 19, column 1, paragraph 2 to column 2, paragraph 2, page 22, column 1, paragraph 4 to column 2, paragraph 2),

the step of retrieving instructional material being performed by the medical information expert (Telemedicine; page 3, column 1, paragraph 4 to column 2, paragraph 1, page 8, column 2, paragraph 1, page 9, column 1, paragraph 3, page 14, column 1, paragraphs 2 to column 2, paragraph 1, page 15, column 1, paragraph 4 to column 2, paragraph 1, page 19, column 1, paragraph 2 to column 2, paragraph 2, page 22, column 1, paragraph 4 to column 2, paragraph 2).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minnesota

Medical Association Report on Telemedicine article, September 1996, URL:

<<http://www.mnmed.org/Protected/telemedicine.pdf>>, hereinafter known as Telemedicine, as applied to claims 1 and 2 above and further in view of Abrahamson et al, U.S. Patent Number 5, 002, 491.

(A) As per claims 3-4, Telemedicine teaches a method as analyzed and discussed in claims 1 and 2 above

wherein the method further comprises the steps of:

if the first physician passes the examination, providing the continuing medical education credit (Telemedicine; page 9, column 2, paragraph 1, page 11, column 2, paragraph 4, page 19, column 1, paragraph 2 to column 2, paragraph 1).

Telemedicine fails to explicitly disclose

providing an examination based on at least the instructional material or the comment to the first physician via the telecommunications system;

receiving answers for the examination from the first physician via the telecommunications system; and



grading the received answers.

However, the above features are well-known in the art, as evidenced by Abrahamson.

In particular, Abrahamson teaches

providing an examination based on at least the instructional material or the comment to the first physician or student via the telecommunications system (Abrahamson; column 3, lines 25-29, column 4, line 26 to column 5, line 41, column 9, line 51 to column 10, line 41, column 11, lines 17-24, column 17, lines 37-45);

receiving answers for the examination from the first physician or student via the telecommunications system (Abrahamson; column 3, lines 25-29, column 4, line 26 to column 5, line 41, column 9, line 51 to column 10, line 41, column 11, lines 17-24, column 17, lines 37-45); and

grading the received answers (Abrahamson; column 3, lines 25-29, column 4, line 26 to column 5, line 41, column 9, line 51 to column 10, line 41, column 11, lines 17-24, column 17, lines 37-45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Telemedicine to include providing an examination based on at least the instructional material or the comment to the first physician or student via the telecommunications system; receiving answers for the examination from the first physician or student via the telecommunications system; and grading the received answers, as taught by Abrahamson, with the motivations of providing facilities for automating the giving and grading of examinations, and for completing other routine paperwork associated with monitoring student progress and recordkeeping (Abrahamson; column 3, lines 24-29).

*Response to Arguments*

9. Applicant's arguments on pages 1-6 of the response filed 6 October 2004 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 6 October 2004.

(A) Applicant arguments at pages 2-3 of the 6 October 2004 response regarding the McAndrew reference are moot in view of the new ground(s) of rejection.

(B) With regard to Applicant's argument at page 4, paragraph 2 of the 6 October 2004 response that, in the Abrahamson reference, "there is nothing whatever about how such systems might be used where education is not taking place in a classroom or where the education is a byproduct of some other activity," Examiner respectfully notes that these limitations were not recited in the claim language.

(C) With regard to Applicant's argument at page 5, paragraph 2 of the 6 October 2004 response that the Abrahamson reference fails to teach the limitations recited in claim 1 of "receiving a comment or information made with regard to the consultation via the telecommunications system from the second physician" and "providing the comment to a medical information specialist in the intermediary who is neither the first nor the second physician, the medical information specialist indicating continuing medical education credit for the first physician based at least on the comment in a database accessible from the intermediary," Examiner respectfully notes that it was not the Abrahamson reference but the Telemedicine reference that was relied on to teach these limitations.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied reference Cook et al., U. S. Patent Number 5, 727, 950, Eggert et al., U. S. Patent Number 5, 853, 292, Eckmann U. S. Patent Number 4, 539, 435, Joao, U. S. Patent Number 6, 283, 761, and the article teach the environment of providing online education and accreditation.

Richert, C. Increasing Your Consultation Base via the World Wide Web. November 1996, Division of Pathology Informatics, University of Pittsburgh Medical Center website. January 1997. [Retrieved on December 29, 2004]. Retrieved from Internet. URL: <<http://web.archive.org/web/19970128170752/http://www.pathology.pitt.edu/apiii/author/work2c.htm>>.

11. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington D.C. 20231**

or faxed to: **(703) 305-7687.**

For informal or draft communications, please label "PROPOSED" or "DRAFT" on the front page of the communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

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Hand-delivered responses should be brought to Crystal Park 5,  
2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (703) 305-3980. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

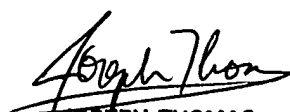
13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (703) 305-9588. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*NP*

Natalie A. Pass

January 4, 2005

  
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